

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. EXAMINER INTERVIEW, CLAIM STATUS & AMENDMENTS

In item 1 on page 1 of the Office Action, it was indicated that the amendment filed October 29, 2006 has been received and entered. Applicants assume the Office meant to refer to the amendment filed October 23, 2006 for there was no amendment filed on October 29, 2006.

Applicants thank Examiner Pryor for the telephone interview of April 9, 2007 to discuss the outstanding rejections. The substance of the interview is discussed below in the relevant sections.

Claims 7, 20, 21, 33, 39, 40, 42, 43 and 47-49 were pending in this application when last examined.

Claims 21, 33, 39, 40, 42, 43, 48 and 49 were examined on the merits and stand rejected.

Claims 7 and 20 were indicated as allowed. Applicants are grateful for the Office's indication of allowable subject matter.

Claims 39 and 40 are amended.

Support for the amendments to "X", "Y" and the indicated chemical bond in claims 39 and 40 can be found in the claims as filed and original claim 4.

Support for the amendment to claims 39 and 40 to recite "A represents dihydrofuran" can be found in the disclosure, for example, at page 36, line 21 to page 37, line 1.

Support for the amendment changing "biological rhythm disorders" to "sleep-awake rhythm disorders" can be found, for example, at page 1, line 11, page 3, lines 22-24 and page 12, lines 15-18 of the disclosure.

No new matter has been added.

II. ENABLEMENT REJECTIONS

A. On pages 2-3 of the Office Action, claims 21, 33, 39, 40, 42 and 43 were newly rejected under 35 U.S.C. § 112, first paragraph, on the basis the Specification is only enabled for a percutaneous absorption preparation comprising (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]acetaminde (A = furan; X=CH₂, Y=C) or (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = furan; X=CH₂, Y=C), and not for a percutaneous absorption preparation comprising compounds of the instant formula disclosed in claims 21, 33, 29, 40, 42 and 43 other than (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = oxazole, etc.; X = NR₄ or O; Y = CH).

This rejection is respectfully traversed as applied to the amended claims.

Applicants again thank Examiner Pryor for the interview on April 9, 2007. During the interview, the Examiner clarified that claims 21, 33, 39, 40, 42 and 43 were rejected for lack of enablement on the basis the Specification does not provide results (data) showing the therapeutic effectiveness (i.e., antagonist effect) for the compounds indicated as non-enabled in the Office Action.

In reply, it is respectfully submitted that the Specification is fully enabled for the claimed invention.

It was noted in the interview that, even if the basis for the rejection was true, the instant rejection should not apply to composition claims 21 and 33 for they do not recite a method of treatment and/or pharmaceutical effect. Therefore, the basis for the rejection does not apply to these claims. During the interview, the Examiner seemed to acknowledge that composition claims 21 and 33 and dependent claims thereof (i.e., claims 43 and 47) should not have been included in this rejection.

The Examiner further noted the enablement rejection still applies to method claims 39, 40 and 39 (and dependent claims thereof), since such claims are directed to methods of treatment. The Examiner argued that the Specification only provides evidence of therapeutic effectiveness (i.e., treatment/antagonist effect) for a percutaneous absorption preparation comprising (S)-N-[2-

(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]acetamide or a compound of claim 39 wherein A = furan; X=CH₂, Y=C) and the compound of (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide or a compound of claim 40 wherein A = furan; X=CH₂, Y=C. It was suggested the claims be limited to the enabled subject matter, in which A is furan, X is CH₂ and Y is C.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, claims 39 and 40 have been amended along the lines suggested by the Examiner. In particular, the claims have been amended such that X represents CH₂, Y represents C, and the indicated chemical bond is a double bond.

Although the Office indicated that "A = furan", please note A should be "dihydrofuran" because B is a benzene ring. Please see the support in the disclosure, for example, at page 36, line 21 to page 37, line 1. Accordingly, the claims have been amended such that A represents "dihydrofuran."

Thus, the claims have been amended along the lines suggested by the Examiner. In other words, the claims have been amended to the subject matter indicated as enabled by the Examiner. For this reason, the 112, first paragraph, enablement rejection of claims 21, 33, 39, 40, 42 and 43 is untenable and should be withdrawn.

B. On pages 2-3 of the Action, claims 39, 40, 42, 43, 48 and 49 were rejected under 35 U.S.C. § 112, first paragraph, on the basis the Specification is only enabled for treating sleep awake rhythm disorders and somnipathy using the specific compounds identified above, and not for treating biological rhythm disorders using a preparation comprising compounds of instant formula disclosed in claims 21 and 33 other than (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = oxazole, etc.; X = NR₄ or O; Y = CH).

It is respectfully submitted the present amendment overcomes this rejection.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, claims 39 and 40 have been amended to the subject matter indicated as enabled by the Examiner.

For this reason, the 112, first paragraph, enablement rejection of claims 39, 40, 42, 43, 48 and 49 is untenable and should be withdrawn.

III. WRITTEN DESCRIPTION REJECTION

On page 3 of the Action, claims 39, 40, 42, 43, 48 and 49 were rejected under 35 U.S.C. § 112, first paragraph, on the basis that the Specification lacks written description support for the phrase "biological rhythm disorders." It was noted the Specification supports treatment of sleep-awake rhythm disorders and somniphath.

The present amendment overcomes this rejection.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, claims 39 and 40 have been amended to the subject matter indicated by the Examiner as supported by the disclosure. Specifically, the term "biological rhythm disorders" is amended to "sleep-awake rhythm disorders."

Thus, in view of the above amendment, the 112, first paragraph, written description rejection of claims 39, 40, 42, 43, 48 and 49 is untenable and should be withdrawn.

IV. CLAIM OBJECTION

On page 3 of the Action, claim 47 was objected to for depending on a rejected base claim. It was indicated that the claim would be allowable, if rewritten into independent form including all of the limitations of the base claim and any intervening claim.

It is respectfully submitted that the objection should be withdrawn, because the present amendments overcomes the above-noted rejections.

V. ALLOWABLE SUBJECT MATTER

On pages 3-4 of the Action, it was indicated that claims 7 and 20 have been allowed. Applicants are grateful for the Office's indication of allowable subject matter.

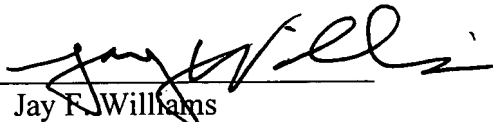
CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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